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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,292	12/02/2003	Shinichi Tsuzaki	JCLA12308	5325

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J C PATENTS, INC.  
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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT PAPER NUMBER

1655

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/727,292

Applicant(s)

TSUZAKI ET AL.

Examiner

S. B. McCormick-Ewoldt

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The amendment of May 3, 2005 is hereby acknowledged.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### Claim Rejections - 35 USC § 102

Claims 1-4 remain rejected under 35 U.S.C. 102(b) as being anticipated by Bryan *et al.* (US 5,994,508) for the reasons set forth in the previous Office action.

Bryan *et al.* (US 5,994,508) disclose using a process of extracting soybean isoflavones with the pH level at about from 4.0 to 5.0 and the temperature typically from about 30° F to about 90° F (i.e. -1° C to 32° C) (column 5, lines 30-35, 53-57 and claims 1, 3-4, 6). Bryan *et al.* does not specifically teach the amounts of isoflavones, crude protein or lipid content of the total solid content of the soybean extract liquid. However, since the extraction is the same the amounts of these compounds would be the same. Applicant's arguments filed May 3, 2005 have been fully considered but are not persuasive.

**Applicant argues** that Bryan collects the insoluble material in the extraction process while in the claimed invention the insoluble material is removed and the soybean extract liquid that contains soluble materials is collected instead. This is not persuasive as shown by Bryan (column 5, lines 16-23) that insoluble vegetable materials are removed and separated and extract is collected as the supernatant. In addition, **Applicant argues** that Bryan contains solid state and the claimed invention is a liquid. This is not persuasive as shown in Examples 1-4, whey (watery part of the curd) is analyzed for isoflavone content.

Therefore, the rejection is maintained and deemed final.

#### Claim Rejections - 35 USC § 103

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan *et al.* (US 5,994,508) in view of Obata *et al.* (US 6,444,239 B2) for the reasons set forth in the previous Office action.

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Bryan *et al.* (US 5,994,508) discloses using a process of extracting soybean isoflavones with the pH level at about from 4.0 to 5.0 and the temperature typically from about 30° F to about 90° F (i.e. -1° C to 32° C) (column 5, lines 30-35, 53-57 and claims 1, 3-4, 6). Bryan *et al.* does not specifically teach the amounts of isoflavones, crude protein or lipid content of the total solid content of the soybean extract liquid. Applicant's arguments filed May 3, 2005 have been fully considered but are not persuasive.

Applicant argues that both Bryan and Obata teach away the claimed invention. This is not persuasive as it shows in Example 2 of Bryan that the wash water provides protein isolates.

Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan *et al.* (US 5,994,508) in view of Obata *et al.* (US 6,444,239 B2) for the reasons set forth in the previous Office action.

The teaching of Bryan is relied upon for the reasons discussed *supra*.

Obata *et al.* (US 6,444,239) disclose using a soybean extract with a protease namely  $\beta$ -glucosidase and with a pH range between 3 to 5. The protease removes components other than the isoflavones and provides insoluble matter (column 3, lines 13, 36-38, 50-54 and claims 1-3). Applicant's arguments filed May 3, 2005 have been fully considered but are not persuasive.

**Applicant argues** that Obata teaches away the claimed invention by the significant difference in  $\beta$ -glucosidase activity. Applicant argues that Obata uses the enzymes for different reasons than Applicant. However, the references taken together teach the claimed invention for the reasons discussed in the previous Office action. In response to Applicant's argument that Obata uses the enzyme in a different manner, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Summary

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

*Susan P. Coe*  
6-30-05  
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PRIMARY EXAMINER